

Attorney Docket No.: BUUV-003.01

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Preparata, et al.

Serial No.: 09/416,779

Filing Date: October 13, 1999

For: *Systems and Methods for Sequencing by Hybridization*

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Art Unit: 1631

Examiner: M. Zeman

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JAN 07 2002

TECH CENTER 1600/2900

CERTIFICATE OF MAILING

I hereby certify that the foregoing document is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, Washington, DC 20231 on November 29, 2001.

William Homan
William Homan

Commissioner for Patents
Washington, DC 20231
Box: Sequence Listing

RESPONSE TO NOTICE TO COMPLY WITH SEQUENCE RULES

Applicants submit herewith a revised sequence listing which is fully compliant with the requirements of 37 CFR 1.821 through 1.825, in response to the Notice to Comply with Sequence Rules mailed October 31, 2001. We submit herewith a hard copy of the sequence listing, a computer readable form of the sequence listing (the diskette), a statement to support filing of the sequence listing and an amendment to direct entry of SEQ ID Nos. into the specification.

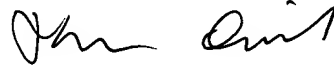
I further state that this submission, filed in accordance with 37 C.F.R. § 1.821(g), does not include new matter.

We believe that we have appropriately provided for fees due in connection with this submission, however, if there are any other fees due in connection with the filing of this Response, please charge the fees to our **Deposit Account No. 06-1448**.

If there are any questions after review of this paper, the Examiner can contact the undersigned as (617) 832-1272.

Respectfully submitted,
FOLEY, HOAG, & ELIOT

November 29, 2001



John D. Quisel
Reg. No. 47,874
Agent for Applicants

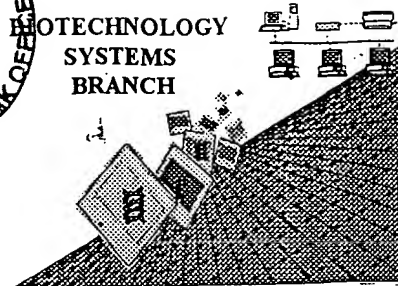
Patent Group
Foley, Hoag & Eliot LLP
One Post Office Square
Boston, MA 02109-2170
Tel: (617) 832-1000
FAX: (617) 832-7000

Ar.
Zeman

re us



RAW SEQUENCE LISTING
ERROR REPORT



The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form:

Application Serial Number: 09/416,779
Source: OIR
Date Processed by STIC: 9/14/2001

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THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.

PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

- 1) INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY or,**
- 2) TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT, WITH A NOTICE TO COMPLY**

FOR CRF SUBMISSION QUESTIONS, PLEASE CONTACT MARK SPENCER, 703-308-4212.

FOR SEQUENCE RULES INTERPRETATION, PLEASE CONTACT ROBERT WAX, 703-308-4216.

PATENTIN 2.1 e-mail help: patin21help@uspto.gov or phone 703-306-4119 (R. Wax)

PATENTIN 3.0 e-mail help: patin3help@uspto.gov or phone 703-306-4119 (R. Wax)

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE CHECKER VERSION 3.0 PROGRAM, ACCESSIBLE THROUGH THE U.S. PATENT AND TRADEMARK OFFICE WEBSITE. SEE BELOW:

Checker Version 3.0

The Checker Version 3.0 application is a state-of-the-art Windows based software program employing a logical and intuitive user-interface to check whether a sequence listing is in compliance with format and content rules. Checker Version 3.0 works for sequence listings generated for the original version of 37 CFR §§1.821 – 1.825 effective October 1, 1990 (old rules) and the revised version (new rules) effective July 1, 1998 as well as World Intellectual Property Organization (WIPO) Standard ST.25.

Checker Version 3.0 replaces the previous DOS-based version of Checker, and is Y2K-compliant. Checker allows public users to check sequence listings in Computer Readable form (CRF) before submitting them to the United States Patent and Trademark Office (USPTO). Use of Checker prior to filing the sequence listing is expected to result in fewer errored sequence listings, thus saving time and money.

Checker Version 3.0 can be down loaded from the USPTO website at the following address:

<http://www.uspto.gov/web/offices/pac/checker>



OIPE

RAW SEQUENCE LISTING
PATENT APPLICATION: US/09/416,779

DATE: 09/14/2001
TIME: 11:11:07

Input Set : A:\09416779 SEQ Listing.txt
Output Set: N:\CRF3\09142001\I416779.raw

Does Not Comply
Corrected Diskette Needed

3 <110> APPLICANT: Preparata, Franco P.
4 Upfal, Eliezer
6 <120> TITLE OF INVENTION: SYSTEMS AND METHODS FOR SEQUENCING BY HYBRIDIZATION
8 <130> FILE REFERENCE: BUV-003.01
10 <140> CURRENT APPLICATION NUMBER: 09/416,779
11 <141> CURRENT FILING DATE: 1999-10-13
13 <160> NUMBER OF SEQ ID NOS: 2
15 <170> SOFTWARE: PatentIn Ver. 2.0

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ERRORED SEQUENCES

17 <210> SEQ ID NO: 1
18 <211> LENGTH: 17
19 <212> TYPE: DNA
20 <213> ORGANISM: Unknown
22 <220> FEATURE:
23 <223> OTHER INFORMATION: Description of Unknown Organism: natural or
24 synthetic oligonucleotide
26 <400> SEQUENCE: 1
E--> 27 acctacgtta gcttatg
30 <210> SEQ ID NO: 2
31 <211> LENGTH: 10
32 <212> TYPE: DNA
33 <213> ORGANISM: Unknown
35 <220> FEATURE:
36 <223> OTHER INFORMATION: Description of Unknown Organism: natural or
37 synthetic oligonucleotide
39 <400> SEQUENCE: 2
E--> 40 tagaccgata
E--> 42

17 ← insert
cumulative
base total
at right
margin
each

10 ←

(20)

delete

VERIFICATION SUMMARY

PATENT APPLICATION: US/09/416,779

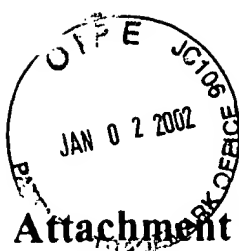
DATE: 09/14/2001

TIME: 11:11:08

Input Set : A:\09416779 SEQ Listing.txt

Output Set: N:\CRF3\09142001\I416779.raw

L:27 M:254 E: No. of Bases conflict, LENGTH:Input:0 Counted:17 SEQ:1
L:40 M:254 E: No. of Bases conflict, LENGTH:Input:0 Counted:10 SEQ:2
M:254 Repeated in SeqNo=2



Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

NOTICE TO COMPLY WITH SEQUENCE RULES

Application No.

09/416,779

Examiner

Mary K Zeman

Applicant(s)

PREPARATA ET AL.

Art Unit

1631

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons:

- ☐ 1. This application clearly fails to comply with the requirements of 37 CFR 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
- ☒ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked up "Raw Sequence Listing".
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable. A Substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ 7. Other:

Applicant must provide:

- ☐ An initial or ☒ A substitute computer readable form copy of the Sequence Listing.
- ☐ An initial or ☐ A Substitute paper copy of the Sequence Listing as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same, and, where applicable, include no new matter, as required by 37 CFR 1.821(e), (f), or (g) or 1.825(b) or (d).

FOR QUESTIONS PLEASE CONTACT:

Rules Interpretation (703) 308-4216
CRF Submission Help (703) 308 4212
PatentIn software help (703) 308 6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE

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Art Unit: 1631

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). A computer readable form (CRF) of the sequence listing was submitted. However, the CRF could not be processed by the Scientific and Technical Information Center (STIC) for the reason(s) set forth on the attached CRF Diskette Problem Report. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

Applicant is given ONE MONTH from the mailing date of this communication within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached CRF Diskette Problem Report with the reply.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133. The examiner can generally be reached between the hours of 7:30 am and 5:00 pm Monday through Thursday, and on alternate Fridays.

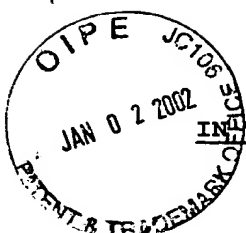
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

Official fax numbers for this Art Unit are: (703) 308-4242, (703) 872-9306. An *unofficial* fax number, direct to the Examiner is (703) 746 5279. Please call prior to use of this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz
10/30/01


MARY K. ZEMAN
PATENT EXAMINER
A1631



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket No: BUU-003.01

In re patent application of

PREPARATA, FRANCO P. et al.

Serial No. 09/416,779

Filed: October 13, 1999

For: SYSTEMS AND METHODS FOR SEQUENCING BY HYBRIDIZATION

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STATEMENT TO SUPPORT FILING AND SUBMISSION IN
ACCORDANCE WITH 37 C.F.R. §§ 1.821-1.825

Assistant Commissioner for Patents
Washington, D.C. 20231
Box SEQUENCE

Sir:

In connection with a Sequence Listing submitted concurrently herewith, the undersigned hereby states that:

1. the submission, filed herewith in accordance with 37 C.F.R. § 1.821(g), does not include new matter;

2. the content of the attached paper copy and the attached computer readable copy of the Sequence Listing, submitted in accordance with 37 C.F.R. § 1.821(c) and (e), respectively, are the same; and

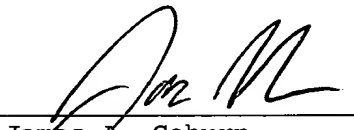
3. all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

Serial No. 09/416,779

States Code and that such willful false statements may jeopardize the validity of the application or any patent resulting therefrom.

Respectfully submitted,

Nov. 19, 2001
Date


James A. Coburn

HARBOR CONSULTING
Intellectual Property Services
1500A Lafayette Road
Suite 262
Portsmouth, N.H.
800-318-3021